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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,024	04/12/2000	Masashi Eguchi	81800-0121	5398

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,024

Applicant(s)

EGUCHI, MASASHI

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 5/18/2005.
2. This application has been reconsidered. Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 4, 5, 8, 9, 13, 14, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumagai et al (Kumagai) (U.S. 6,313,926).

With respect to claims 1 and 14, Kumagai discloses a network facsimile machine (which reads on 201 and 118, figure 1) connectable to a PSTN (116) and a second network (117 or 119)

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and adapted to receive fax data from a remote machine over the PSTN and deliver the fax data to recipients on the second network (column 5, line 45 to column 6, line 30), the facsimile machine comprising a capabilities storage unit that stores data for delivery recipients on the second network and stores reception capabilities for delivery recipients (column 2, lines 47-50; column 4, lines 5-13 and 37-43, and column 6, lines 54-64), and a communication control unit (101) that receives delivery recipient specifying data over the PSTN, looks up the data in the capabilities storage unit and transmits a signal over the PSTN pertaining to reception capabilities of a delivery recipient (column 6, lines 7-15 and column 8, lines 1-8).

With regard to claims 4, 5, 8, 9, 17, and 18, Kumagai discloses the delivery recipient is a terminal device or output device on the second network (column 3, lines 26-41 and column 4, lines 30-44).

With respect to claim 13, Kumagai discloses the second network is a LAN (column 3, lines 26-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 6, 7, 10, 15, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai in view of Maeda (U.S. 6,437,873).

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With respect to claims 2, 3, 15, and 6, Kumagai differs from claims 2, 3, 15, and 16 in that he does not clearly disclose the delivery recipient data is a sub-address or TSI signal.

Maeda discloses a network facsimile machine wherein the delivery recipient-specifying data is a sub-address (SUB) (fig. 4, col. 5, lines 18-24) and a Transmitting Subscriber Identification (TSI) signal (fig. 4, col. 5, lines 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumagai wherein the delivery recipient data is a sub-address or TSI signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumagai by the teaching of Maeda in order to improve the delivery process.

With regard to claims 6 and 7, Maeda discloses the network facsimile machine of claim 2 wherein the capabilities storage unit (12) stores addresses of the delivery recipients on the second network (4), the recipient -specifying data, and reception capabilities of said delivery recipients in predetermined correspondence (fig. 6, col. 5, lines 60-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumagai by the teaching of Maeda in order to ensure delivery to the intended recipient.

With respect to claims 10 and 19, Maeda discloses the network facsimile machine of claim 1 wherein the reception capabilities include resolution (fig. 1, column 3, lines 33-38, fig. 6, column 6, lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumagai by the teaching of Maeda in order to improve the printing process.

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7. Claims 11, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai in view of Oseto (U.S. 6,097,797).

With regard to claim 11, Kumagai not clearly disclose when broadcasting to a plurality of delivery recipients on the second network, the reception capabilities of a delivery recipient with the lowest reception capability is declared.

Oseto discloses wherein when broadcasting to a plurality of delivery recipients on the second network, the reception capabilities of a delivery recipient with the lowest reception capability is declared (fig. 2, column 7, lines 13-17).

It would have been obvious to one skilled in the art at the time of the invention to modify Kumagai wherein the range of reception capabilities are identified for precise matching of a specific device to prevent error during the transmission process.

With respect to claim 12, Kumagai does not disclose when broadcasting to a plurality of delivery recipients on the second network, the reception capabilities of a delivery recipient with the highest reception capability is declared.

Oseto discloses when broadcasting to a plurality of delivery recipients on the second network, the reception capabilities of a delivery recipient with the highest reception capability is declared (fig. 2, column 7, lines 17-20). It would have been obvious to one skilled in the art at the time of the invention to modify Kumagai wherein the range of reception capabilities are identified for precise matching of a specific device to prevent error during the transmission process.

With regard to claim 20, Kumagai does not disclose a plurality of delivery recipients are designated by the recipient-specifying data at step B, reception capabilities of each of the

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plurality of delivery recipients are determined at step, and a signal declaring the reception capabilities of a delivery recipient with the lowest reception capabilities is transmitted to the remote facsimile machine over the PSTN at step D.

Oseto discloses wherein a plurality of delivery recipients are designated by the recipient-specifying data at step B (fig. 11, column 13, lines 31-41), reception capabilities of each of the plurality of delivery recipients are determined at step C (fig. 7, column 10, lines 45-67 and column 11, lines 1-14), and a signal declaring the reception capabilities of a delivery recipient with the lowest reception capabilities is transmitted to the remote facsimile machine over the PSTN at step D (fig. 7, column 10, lines 23-44).

It would have been obvious to one skilled in the art at the time of the invention to modify Kumagai wherein the range of reception capabilities are identified for precise matching of a specific device to prevent error during the transmission process.

Response to Arguments

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

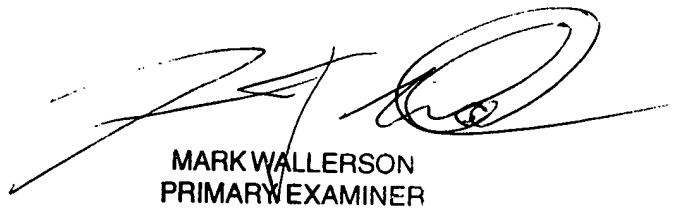
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER